

REMARKS

This is a full and timely response to the final Official Action mailed on June 16, 2004 (Paper No. 4). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, claims 1, 2, 9, 10, 17 and 20 have been cancelled. Claims 3, 6, 11, 14, 18, 19, 21 and 22 have been amended. Each amended claim has simply been rewritten as an independent claim, including the recitations of a previously base claim. No other amendments are proposed by this paper. Following entry of this amendment, claims 3-8, 11-16, 18, 19 and 21-28 will remain pending for consideration.

With regard to the prior art, claims 1, 3-9 and 11-29 were rejected as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of U.S. Patent Publication No. 2002/0104097 to Jerding et al. ("Jerding") and U.S. Patent Publication No. 2002/0116706 to Bahraini ("Bahraini"). Claims 2 and 10 were rejected as unpatentable over the combined teachings of Jerding, Bahraini and U.S. Patent No. 5,883,901 to Chiu et al. ("Chiu"). For at least the following reasons, these rejections are respectfully traversed.

The merits of these rejections were discussed in a telephone interview between the Examiner and the undersigned on August 19, 2004. The undersigned wishes to thank the Examiner for taking the time to conduct this interview and for the helpful comments made. The positions taken by Applicant in this response are based, in part, on the discussion with the Examiner of August 19th.

Claim 23 recites:

A set-top unit for connection to a cable television system comprising:
a control channel tuner;
at least one programming tuner; and
a processor for controlling both said tuners;
wherein said processor is configured to concurrently control both said control channel tuner and said at least one programming tuner to scan a frequency band to locate a control channel.
(emphasis added).

In contrast, the combination of Jerding and Bahraini fails to teach or suggest using two tuners concurrently, a control channel tuner and a programming tuner, to locate a control channel. As represented by the Office, Jerding teaches a set-top including two tuners, and Bahraini teaches using a single tuner to scan for a control channel. However, neither reference teaches or suggests a set-top unit that includes and concurrently uses two tuners to scan a frequency band to locate a control channel, as claimed.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). For at least this reason, the rejection of claims 23-27 should be reconsidered and withdrawn.

Claim 28 recites:

A set-top unit for connection to a cable television system comprising:
a control channel tuner;
two or more programming tuners; and
a processor for controlling said tuners;
wherein said processor is configured to concurrently control said programming tuners to scan a frequency band to locate a control channel.

As demonstrated above, the combination of Jerding and Bahraini fails to teach or suggest using two or more tuners *concurrently* to scan a frequency band to locate a control

channel, as claimed. Again, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). For at least this reason, the rejection of claims 28 and 29 should be reconsidered and withdrawn.

Claim 6 recites:

A set-top unit for connection to a cable television system comprising:
a control channel tuner;
at least one programming tuner; and
a processor for controlling said tuners;
wherein said processor controls said at least one programming tuner to scan a frequency band to locate a control channel;
wherein said processor divides said frequency band among said control channel tuner and said at least one programming tuner, and controls each said tuner to search a different portion of said frequency band for said control channel.
(emphasis added).

Claims 14, 19 and 22 recite similar subject matter.

Thus, these claims, as exemplified by claim 6, again recite that two tuners, a control channel tuner and a programming tuner, are used together to locate a control channel. The frequency band to be searched is divided among the two tuners so that the search can be completed more quickly.

As demonstrated above, the combination of Jerding and Bahraini fails to teach or suggest using two tuners to search for a control channel. The combination further fails to teach or suggest dividing a frequency band among the two tuners as described in claim 6.

Again, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). For at least

this reason, the rejection of claims 6-8, 14-16, 19 and 22 should be reconsidered and withdrawn.

Claim 3 recites:

A set-top unit for connection to a cable television system comprising:
a control channel tuner;
at least one programming tuner; and
a processor for controlling said tuners;
wherein said processor controls said at least one programming tuner to scan a frequency band to locate a control channel;
wherein said processor controls said at least one programming tuner to tune frequencies in said frequency band and identify frequencies carrying an active signal;
and
wherein said processor controls said control channel tuner to tune said frequencies carrying an active signal to locate said control channel.
(emphasis added).

Claims 11, 18 and 21 recite similar subject matter.

Thus, these claims, as exemplified by claim 3, again recite that two tuners, a control channel tuner and a programming tuner, are used together to locate a control channel. One tuner is used to search for frequencies carrying an active signal, while the second tuner is used to tune those frequencies with active signals to determine which is a control channel.

As demonstrated above, the combination of Jerding and Bahraini fails to teach or suggest using two tuners to search for a control channel. The combination further fails to teach or suggest using the two tuners as described in claim 3, one to search for active signals and one to determine if an active signal, once located, is a control channel.

Again, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). For at least

this reason, the rejection of claims 3-5, 11-13, 18 and 21 should be reconsidered and withdrawn.

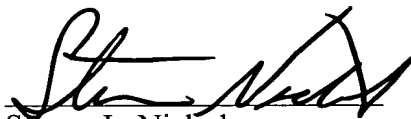
Entry and consideration of this amendment are proper under 37 C.F.R. § 1.116 for at least the following reasons. The present amendment does not introduce any new claims or raise new issues requiring further search. The only changes made by the present amendment are to rewrite a number of formerly-dependent claims as independent claims. Specifically, the recitations of claim 1 have been added to formerly-dependent claims 3 and 6. The recitations of claim 9 have been added to formerly-dependent claims 11 and 14. The recitations of claim 17 have been added to formerly-dependent claims 18 and 19. The recitations of claim 20 have been added to formerly-dependent claims 21 and 22.

Thus, the amendment does not raise new issues requiring further search or consideration. And, places the application in condition for appeal. Therefore, entry of the present amendment is proper under 37 C.F.R. § 116 and is hereby requested.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper which have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: 20 August 2004



Steven L. Nichols
Registration No. 40,326

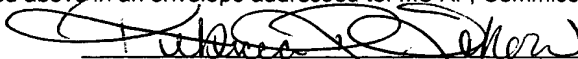
Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095

(801) 572-8066
(801) 572-7666 (fax)

CERTIFICATE OF MAILING

DATE OF DEPOSIT: August 20, 2004

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail on the date indicated above in an envelope addressed to: MS AF, Commissioner for Patents, Alexandria, VA 22313-1450.


Rebecca R. Schow